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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,497	05/10/2004	Joe Stockwell	37015.0300	3496

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EXAMINER

WRIGHT, PATRICIA KATHRYN

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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08/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/709,497	Applicant(s) STOCKWELL, JOE	
	Examiner P. Kathryn Wright	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 02, 2009 has been entered.

Status of the Claims

2. This action is in response to papers filed July 02, 2009 in which claims 1, 3, and 6-8 were amended. Claims 12-20 remain withdrawn. The amendments have been thoroughly reviewed and entered.

New grounds for rejection, necessitated by the amendments, are discussed.

Claims 1-11 are under prosecution.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites wherein the openings in the frame comprise horizontal separated by "the elongated rails", which fit in the elongated slots. It is not clear from the claim

which elongated slots Applicant is referring to since claim 2 (from which claim 3 depends) recites the plug members of the transfer plate are separated by elongated slots and the frame also includes elongated slots.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2 and 4-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Arnold, Jr. et al., (US Patent No. 5,497,670), hereinafter “Arnold”.

Arnold teaches an apparatus for transferring pipette tips comprising:

a transfer plate 36 having a plurality of plug members 38 for engaging pipette tips 11, wherein the plurality of plug members are part of the transfer plate (see for example paragraph [0026] and Fig. 6); and

a frame 20 assembled and interlocked with the transfer plate (see Figs. 7-8), the frame having openings 22 contained therein for inserting the plug members therethrough (see paragraph [0026]) and a plurality of protuberances 23 smaller than the plug members and extending into the openings. The protuberances are part of the frame 20 (see Figs. 4-5).

As to claim 2, the plug members 38 are arranged in parallel lines separated by elongated slots created by the shoulders 42, see Fig. 6.

Regarding claim 4, Arnold does teach all components, including the transfer plate and frame, being made of plastic (see paragraph [0029]). It is the inherent nature of plastic to be “moldable” given the necessary pressure and/or temperature.

As to claim 5, the plug members 38 are hollow, see Figs. 2 and 6.

Claim 6 functionally describes the operation of the apparatus. Please note that a recitation with respect to the manner in which a claimed apparatus is intended to be operated fails to differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. The retained and released positions are not structurally defined in the claims. Nevertheless, Arnold does teach vertically sliding the transfer plate 36 (e.g., down) relative to the frame 20, see Figs 6-8. The transfer plate 36 can be slid downward to a retained position (see Fig. 6) and a released position (see Fig. 8) when the plugs 38 have pipette tips 11 positioned thereon.

Regarding claim 7, the protuberances 23 contact the pipette tips 11 positioned over the plug members 38 on transfer plate 36, when the apparatus is in the retained position as shown in Fig. 6.

As to claim 8, the protuberances 23 are located between the shoulders 41 of plug members 38 when the apparatus is in a released position (see Fig. 8).

As to claim 9, the transfer plate 36 further comprises at least one “tab member” for sliding the frame relative to the transfer plate. That is, the flat body 37 of the transfer plate 36 in Arnold reads on the “tab member” since it projects horizontally from the plug members so that the user may use the overhang to grip and slide the transfer plate 36

relative to the frame 20. Nothing in the claim structurally distinguishes the tab member from the overhang on the transfer plate 36 in Arnold.

With regard to claim 10, transfer plate 36 and the frame 20 are generally rectangular in shape, see Fig. 2.

As to claim 11, the transfer plate 36 and the frame 20 are removable from one another (see for example Fig. 7).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (US Patent No. 5,497,670).

The teachings of Arnold have been summarized above. While Arnold does show circular openings 22 in the frame 20 that are separated by elongated rails 27, Arnold is silent to the shape of the openings being horizontal elongated slots. However, it would

have been obvious to one of ordinary skill in the art at the time of the claimed invention to construct the openings in the frame as horizontal elongated slots since the skilled artisan would be able determine the optimum shape for holding the pipette tips securely in the frame yet large enough that the tips don't become difficult remove from the frame. In addition, it has been held that changes in shape are a matter of choice that a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed element was significant, see MPEP 2144.4 (B).

Response to Arguments

10. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. No claims are allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is (571)272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. Kathryn Wright/
Examiner, Art Unit 1797